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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,414	12/27/2001	Christopher Pasqualino	13315US02	1160
23446 7590 01/20/2010 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
PHILIPPE, GIMS S				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
01/20/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/034,414

Applicant(s)

PASQUALINO, CHRISTOPHER

Examiner

Gims S. Philippe

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Response to Amendment

1. Applicant's response received on September 14, 2009 has been fully considered and entered, but the arguments are not deemed to be persuasive.

Response to Arguments

The applicant noted that US Patent Application no. 2002/0186322 to Mair et al. was filed on October 15 2001 and claimed priority to provisional application no. 60/296,924, filed June 8, 2001. The applicant further argues that serial no. 60/296,924 does not properly support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112 first paragraph.

The examiner respectfully disagrees. The provisional application, while it may appear to the applicant as a paper or proposal. The proposal submitted on the provisional application contains the elements to meet the 35 U.S.C. 112 first criteria.

The provisional application notes in the introduction that The DVI signal perform the encoding while two additional bits perform specific and distinct functions (See Introduction of the Provisional Application). The first and second functions of bits 8 and 9 in addition to the fact that DC balancing will be used to transport audio information are important in considering the proposal. The elements of the Abstract in the Application of Mair et al. (i.e., Publication no. 2002/0186322 A1) are proposed in the Introduction of the provisional. In addition, the Principle of operation as well as in the section named "proposal" were considered by the examiner. Considering the fact that the elements of

the abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the provisional application), it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the applicant.

The examiner wishes to note that while the applicant's provisional application contains all the part of a regular application, the proposal submitted by Mair in the provisional application is considered valid as well since to the examiner the requirements for the 35 U.S.C. 112 first paragraphs are present.

The rejection is repeated for the sake of completeness.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

As per claims 19-21, Mair discloses a system for transmitting auxiliary data in video encoding comprising an encoder and a decoder adapted to communicate with encoders (See Abstract, and paragraph [0042], lines 4-6; and [0043]).

It is noted that while Mair provides the encoding and decoding in figs. 3A, 3B and 5, it is silent about the enhanced and un-enhanced aspect of the coding/decoding process. However, from paragraphs [0041 to paragraph 0044] Mair discloses several encoding and decoding techniques wherein the encoding is performed with modulation, and the receiver/decoder receives the data without being encoded in [0044], and the receiver/decoder may send recovered auxiliary data to generate data path based on the accuracy of the auxiliary data. These steps are considered either equivalent or render the enhanced and un-enhanced encoding/decoding obvious to one skilled in the art since the purpose of using enhanced/or unenhanced decoder/encoder is to transmit the auxiliary data without prior knowledge of the capability of the video received receiving auxiliary data as suggested by Mair in [0044].

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (10:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit: 2621

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Gims S Philippe
Primary Examiner
Art Unit 2621

/G. S. P./
/Gims S Philippe/
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